

REMARKS

Claims 51 and 59-69 have been canceled, without prejudice. Claims 52, 53, 55 and 56 have been made dependent on claim 54. Claim 54 has been rewritten in independent form. The application as amended now contains claims 52-58. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Claims 52 and 54 are rejected under 35 U.S.C. § 103 as being unpatentable over Dewallens. Reconsideration is respectfully requested. Dewallens refers to a system for plating a gramophone die. The die 15, 16 has a hole through the center. An electric contact screw 13 extends through the central hole, to fasten the die 15, 16 to a rotating tray 6.

Claims 52 and 54 each recite an apparatus that has a support with conductive contacts for holding a substrate. The plural contacts are an important aspect of the claimed invention. Please refer, for example, to Applicant's specification, page 6, lines 22+. Dewallens fails to disclose or suggest the plural contacts of claims 52 and 54. Dewallens employs a single screw through the central hole of the gramophone die. Therefore, the rejection based on Dewallens should be withdrawn.

The Office Action argues it would have been obvious to provide plural contacts in the Dewallens system because "current would have been divided between contacts allowing increased current carrying capacity without degrading the workpiece." There is nothing in the prior art, however, to support such argument. The argument seems to have been made up by the Examiner with the benefit of Applicant's own disclosure, which is not a proper basis for supporting a rejection.

Claims 53 and 55-58 should be allowable along with independent claim 54 and for other reasons.

Claims 52-58 are further rejected under 35 U.S.C. § 103 as being unpatentable over Reid in view of Landau and Dewallens. Reconsideration is respectfully requested. Reid refers to a system for plating a semiconductor wafer. Reid seeks to avoid a "terminal effect" at the edge of the wafer by changing current density over time in a step-wise fashion (column 4, lines 9-41). Landau is merely cumulative to Reid in this respect.

It is not proper to combine references where doing so "would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." In re Ratti, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959). This is well settled Office policy. See M.P.E.P. § 2143.01, page 2100-127 (Feb. 2003). The "modification" proposed by the Examiner in the rejection of claims 52-58 would require a substantial reconstruction and redesign of the elements of the Reid/Landau systems as well as a change in the basic principle under which they were designed to operate (stepped current density). Consequently, the rejection should be withdrawn.

Finally, please note that a Notice of References Cited (PTO-892) was not enclosed with the April 23, 2004 Office Action, although the Office Action indicates that a Notice was attached. The Office is respectfully requested to provide Applicant's undersigned representative with a copy of the Notice.

Application No.: 09/813,164

Docket No.: M4065.0187/P187-B

Allowance of the application with claims 52-58, as amended, is solicited.

Dated: May 31, 2004

Respectfully submitted,

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